



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,837	03/20/2001	Shunpei Yamazaki	12732-022001 / US4790	8400

26171 7590 02/13/2004
FISH & RICHARDSON P.C.
1425 K STREET, N.W.
11TH FLOOR
WASHINGTON, DC 20005-3500

EXAMINER

CHIANG, JACK

ART UNIT	PAPER NUMBER
----------	--------------

2642

DATE MAILED: 02/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/811837

Applicant(s)

Yamazaki ET AL.

Examiner

J. Chiang

Group Art Unit

2642

7

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE -1- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 3-20-01 r
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-103 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 1-103 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

09/811,837

RESTRICTION

1. Restriction to one of the following inventions is required under 35 U.S.C.

121:

- I. Claims, 1, 3 and 12 and their dependent claims, drawn to a telephone, classified in class 379, subclass 433.01.
- II. Claims 4-9, 13-15, 23-30 and their dependent claims, drawn to phone having panels, classified in class 379, subclass 433.13.

2. Inventions Group I and II are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Group I does not require panels. The subcombination has separate utility such as PDA or pocket PC etc..

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. This application contains claims directed to the following patentably distinct species of the claimed invention:

Group I, claims, 1, 3 and 12 and their dependent claims contains the following species:

Specie 1, claims 1-2, keys having LED;

Specie 2, claim 3, keys having LCD;

Specie 3, claim 12, keys having EL elements;

Specie 4, EL efficiency of 10% with keys having LED

Specie 5, EL of 251m/W with keys having LED

Specie 6, CCD light receiving portion with keys having LED

Specie 7, touch display with keys having LED

Specie 8, EL efficiency of 10% with keys having LCD

Specie 9, EL of 251m/W with keys having LCD

Specie 10, CCD light receiving portion with keys having LCD

Specie 11, touch display with keys having LCD

Specie 12, EL efficiency of 10% with keys having EL

Specie 13, EL of 251m/W with keys having EL

Specie 14, CCD light receiving portion with keys having EL

Specie 15, touch display with keys having EL

Group II, claims, 4-9, 13-15, 23-30 and their dependent claims contains the following species:

Specie 1, claim 4, 6, panels and keys having LED;

Specie 2, claim 5, 7, panels and keys having LCD;

Specie 3, claim 13, 14, panel and keys having EL;

Specie 4, claim 8, keys having LED and display have a specific pixels;

Specie 5, claim 9, keys having LCD and display having a specific pixels;

Specie 6, claim 15, keys having EL and display having a specific pixels;
Specie 7, claim 23, 25, keys having LED, image displayed by the EL and LED
are the same;
Specie 8, claim 24, 26, keys having LCD, image displayed by the EL and LED
are the same;
Specie 9, claim 27, 28, keys having LED, angle recognition;
Specie 10, claim 29, 30, keys having LCD, angle recognition;
Specie 11, EL efficiency of 10% under species 1-10 above;
Specie 12, EL of 251m/W under species 1-10 above;
Specie 12, CCD light receiving portion under species 1-10 above;
Specie 14, touch display under species 1-10 above.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no generic claim.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by

37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. A telephone call was made to Mr. John Hayden on 02-06-04 to request an oral election to the above restriction requirement, Mr. Hayden has asked for a written restriction.

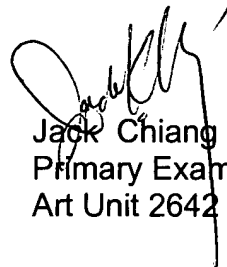
7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

NOTE: applicant is advised to elect one specie in either Group I or Group II for examination purpose.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack Chiang whose telephone number is 703-305-4728. The examiner can normally be reached on Mon.-Fri. from 8:00 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on 703-305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jack Chiang
Primary Examiner
Art Unit 2642